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7590

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R. Scott Weide  
Weide & Associates, Ltd.  
11th Floor, Suite 1130  
330 South 3rd Street  
Las Vegas, NV 89101

EXAMINER

WHITE, CARMEN D

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/880,474

Applicant(s)

BENBRAHIM, JAMAL

Examiner

Carmen D. White

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-8, 10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by ***Alcorn*** et al (5,643,086).

Regarding claims 1-2 and 4-8, Alcorn teaches a method of providing control code/operating data for operating a casino gaming device that includes encrypting the data in a symmetrical (private key) encryption process with a first key (col. 10, lines 27-30); providing said encryption data to said gaming device; initiating operation of said gaming device; locating a decryption device; providing said encrypted data to said decryption device; decrypting said encrypted data with said decryption device using said first key and storing the decrypted data (Fig. 4; Fig. 5; col. 2, lines 44-63).

Regarding claim 10 and 13, Alcorn teaches all the limitations of the claim as discussed above. Alcorn further teaches the storage of the private decryption key in a secure access module (ROM) and the computer program access this key for decryption (col. 3, lines 1-11; Fig. 3 (#29, #33, #34); col. 10, lines 21-30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Alcorn*** et al (5,643,086).

Regarding claims 3 and 15, Alcorn teaches all the limitations of the claims as discussed. While Alcorn teaches encryption of game data prior to installation in the gaming machine (col. 2, lines 40-41), Alcorn is silent regarding explicitly stating the step of transmitting this data to the gaming machine. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the transmission of this encrypted code to the gaming machine in Alcorn, so that the machine could be easily programmed with new game updates.

Regarding claim 9, Alcorn teaches all the limitations of the claims as discussed. While Alcorn teaches the use of a key to decrypt the data (Fig. 3, Fig. 5), Alcorn is silent as to the separate storage of the decryption device (program) and the decryption key which requires the transmission of the key to the device. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of having the decryption key located remotely from the decryption device and to transfer the key to the device in Alcorn. This would increase the security of the system by

Art Unit: 3714

having the two located in separate locations, in cases where one memory location is compromised.

Regarding claim 14, Alcorn teaches all the limitations of the claims as discussed. While Alcorn teaches the use of program memory that has read/write access (col. 2, lines 26-28), Alcorn is silent regarding this memory being a RAM. The examiner takes official notice that it is well known in the art to use RAM as a form of read/write memory. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include a RAM as the read/write program memory of Alcorn. This would allow easy access to the game data in cases of upgrades.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Alcorn** et al (5,643,086) in view of **Wright** (6,052,466) or **Elliott** (6,468,160).

Regarding claims 16-17, Alcorn teaches all the limitations of the claims as discussed above. While Alcorn teaches the use of a private key encryption/decryption system and the storage of this private key in a secure access module (see above), Alcorn is silent regarding the use of a first and second private key for encrypting and decrypting a first and second portion of operating data. In an analogous cryptographic system for the secure access and storage of operating data, Wright or Elliott teaches the use of multiple private keys to encrypt different portions of operating data in a computer system (Wright- abstract and Fig. 3; Elliott- last 3 lines of abstract; Fig. 1B; col. 2, lines 65-67; col. 3, lines 8-22). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the use of multiple private encryption/decryption keys, as taught by Wright or Elliott, in the invention of Alcorn in

order to increase the security of the system, by making it more difficult for an unauthorized person to access both private keys in order to decrypt and read the operating data. This would make it more difficult to alter or delete needed operating data.

***Examiner's Response to Applicant's Remarks***

Applicant argues that Alcorn does not teach or suggest encrypting actual operating code in a symmetrical encryption process as in the present invention. Applicant also argues that Alcorn does not teach decryption of code. The examiner disagrees with this argument. Alcorn clearly teaches an encryption/decryption authentication procedure that is used on all *casino game software, both programs and fixed data sets* (lines 20-22 of abstract)- which has been interpreted by the examiner as operating code/operating data. Further, Applicant argues language that is not used in all of the claims. Applicant uses the language *operating code* in claims 1-4 and the broader term *operating data* in the remaining claims.

The examiner maintains the rejection of the instant claims in view of Alcorn, and the new claims have been addressed with Alcorn, Wright and Elliott. The Alcorn reference clearly teaches the encryption/decryption of game operating code using a private key system. Alcorn also goes a step further than the instant claimed invention by providing an encrypted signature (encrypted hash) of the operating data for additional security.

The examiner would like to notify Applicant about the recent statutory changes to 35 U.S.C. § 102(e) {see attachment- ***Recent Statutory Changes to 35 U.S.C. § 102(e)***}.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **USPTO Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for **Unofficial** communications and 703-305-3579 for all **Official** communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

  
cdw

  
S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700



## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.